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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/778,619 | 02/07/2001 | Richard K. Duggan | CA920000050US1 | 7788 |
| 25259 | 7590 | 07/21/2004 | EXAMINER | |
| IBM CORPORATION 3039 CORNWALLIS RD. DEPT. T81 / B503, PO BOX 12195 REASEARCH TRIANGLE PARK, NC 27709 | | | GECKIL, MEHMET B | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2142 | |

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-------------------------------|--|
| Office Action Summary | Application No. 09/778,619 | Applicant(s) DUGGAN ET AL. | |
| | Examiner Mehmet B. Geckil | Art Unit 2142 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-34 are presented for examination.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 6-7, and 23-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 6-7, and 23-24 recite a program causing a computer to perform some steps. A program not claimed as embodied in computer readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. (See MPEP section 2106, Seventh Edition, Revision No. 1 dated February 2000, at page 2100-10 and 2100-11.)

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morshed et al.

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6. Morshed et al (6,760,903) taught the invention substantially as claimed (as in exemplary claim 8) including a monitoring system (Figures 33-34, monitor dll; collector) embedded within a computing system for providing performance data to a performance tool or monitor program running on a client computer, where the computing system and the client computer are in communication over a network using a network protocol, comprising:

- a) a communication system to receive a request for performance data from the performance tool, where the request is transported over the network (column 41, line 41 et seq);
- b) a data collection system or collector to obtain the performance data as per request (column 42, line 3 et seq and line 43 et seq);
- c) a processing system to place the performance data into a data structure or response (column 41, line 20 et seq);
- d) wherein the communication system provides the data structure or response for transport to the performance tool over the network (col 41, lines 54-55.)

7. It would have been obvious to one of ordinary skill in the networking art at the time of the invention that the claimed invention differed from the teachings of Morshed et al only by a degree, e.g. in the claimed formatting the performance data into a data structure in order to send the response to the client but this is no more than a difference in a degree because Morshed et al also placed the data into a data structure for response and this data was in accordance with the http protocol (see col 41, line 3 et seq) therefore it comes to mean that the data structure of the response was in a format

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the client web browser could use and display, i.e., for example in html or its variations, e.g. xml (see col 41, lines 30-31.) Other claimed features are all obvious variations of the well known features of the web and Internet art. For example, using servlets or cgi scripts in the server side to process the client request are well known in the art and are obvious variations of the server structure of Morshed et al teachings.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Spaur et al (5,732,074) taught a monitoring system for a vehicle through the Internet which included a controller which stores the collected data in the html format (col 3, line 20 et seq and col 3, line 36 et seq) and a protocol converter (30) which encapsulates or converts the data into an http format for transmitting through the Internet. Applicant should note the high quality of this reference. Examiner could write a rejection based on this reference but since there is already one rejection, examiner is just point out high quality of the reference to the applicant.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mehmet Geckil whose telephone number is (703) 305-9676. The examiner can normally be reached on Monday through Friday from 6:30 A.M. to 3:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Jack Harvey, can be reached on (703) 305-9705. The fax phone numbers for the organization where this application or proceeding is assigned are listed hereinbelow.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800/4700. Customer service number is (703) 306-5631.

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Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

or faxed to:

(703) 872-9306

Hand-delivered responses should be brought to Crystal Park II, 2021
Crystal Drive, Arlington, VA., Fourth Floor (Receptionist).

7/16/04

Meht. Geckil

MEHMET B. GECKIL
PRIMARY EXAMINER